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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/595,839 | 06/16/2000 | Daniel Schreiber | 5015 | 1524 |

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EXAMINER

JACKSON, JENISE E

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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2131

DATE MAILED: 01/02/2002

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/595,839

Applicant(s)

SCHREIBER ET AL.

Examiner

Jenise E Jackson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-18 and 27-33 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 12-18 and 27-33 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 9. 6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. As per claim 12, Nguyen discloses providing a software application(i.e. applet) with an associated security authentication requirement to a client via a network(see col. 3, lines 31-39), although Nguyen discloses a unique identifier that is associated with an applet, Nguyen also discloses that a password may be associated with an applet, or other security authentication requirements(see abstract lines 15-16), receiving a request for information from the software application(i.e. applet)via the network, the request includes an associated password, because Nguyen discloses a client(110) connected to a network, such as the Internet(see col. 2, lines 52-58) sends a request using a browser to a server(120) also connected to the network(see col. 2, lines 61-67, and col. 3, lines 1-2), and the request is for a software application(i.e. applet) or web document(see col. 2, lines 67-68), authenticating a password or unique identifier(see col. 3, lines

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36-39, 49-52), providing the information to the software application(i.e. applet) via the network (see col. 3, lines 31-36), while the associated password is valid is inherent, because Nguyen discloses that no other further information is provided unless one of a set of conditions is met; one of these conditions is a program applet can be limited to presenting the further information only if the user presents a selected authenticator, such as a password(see col. 3, lines 49-52), thus if the password is not valid the information will not be provided. Also, Nguyen inherently discloses an invalidation event, because Nguyen discloses, "only if the user presents a selected authenticator that is associated with a applet; therefore, if the user does not present an associated password, the password is invalidated(see col. 3, lines 49-52).

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 13-14, 29 rejected under 35 U.S.C. 103(a) as being unpatentable over Nguyen in view of Ananda as per claim 12 above.

4. As per claims 13-14, and 28-29Ananda discloses invalidating a password after a predetermined time, and after a predetermined elapse in time from when a request was received(see col. 5, lines 5-8), the motivation to do so is that it prevents a user from copying the application software to a storage device(see col. 5, lines 18-23).

5. As per claims 15 and 30, the Examiner takes Official Notice that it is well-known to invalidate a password upon detection of a loss of communication with the client, the motivation

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is that the password can be intercepted and used by another client on the network, if the password is not invalidated.

6. As per claims 16 and 31, Nguyen discloses providing the software application in the form of an applet(124)(see fig. 1).

7. As per claims 17 and 32, Nguyen discloses providing the password assembled with the software application(i.e. applet)(see col. 3, lines 49-52).

8. As per claims 18 and 33, Nguyen discloses generating the password at a server upon receiving the request at the server, although Nguyen discloses generating a unique id(see col. 3, lines 25-30), Nguyen also discloses that other authentication methods can be used, such as a password(see abstract, lines 14-17, and col. 3, lines 49-52).

9. As per claim 27, although Nguyen does not explicitly disclose a password validation and invalidation apparatus, the Examiner takes Official Notice that it is well-known to have an apparatus to validate and invalidate passwords, the motivation is that only authorized users with valid passwords will have the authority to perform certain tasks.

10. Also, as per claim 27, is rejected under same basis as claim 12, and further rejected as Nguyen discloses a server that generates(i.e. creates) a password or(i.e. unique id)(see col. 3, lines 25-27, 49-52), and a restricted access storage area(122)(see fig. 1)(see col. 3, lines 17-21).

Cited Not But Applied

11. US(6,240,450) Sharples discloses a user being required to enter a valid password in order to obtain the software application.

12. US(6,260,141) Park discloses a software license control system based on independent software registration server.

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13. US(5,509,070) Schull discloses a method for encouraging purchase of executable and non-executable software.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jenise E Jackson whose telephone number is (703) 306-0426.

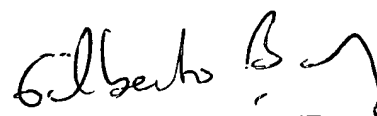
The examiner can normally be reached on M-Th (6:00 a.m. - 3:30 p.m.) alternate Friday's.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gail Hayes can be reached on (703) 305-9711. The fax phone numbers for the organization where this application or proceeding is assigned are Official Communications (703) 746-7239, Non-Official (703) 746-7240, and After Final communications (703) 305-7238.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.



December 20, 2001



GILBERTO BARRON, JR.
PRIMARY EXAMINER
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